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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/561,863

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Peter Risberg

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23338 7590 08/18/2008  
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EXAMINER

CHARLES, MARCUS

ART UNIT

PAPER NUMBER

3682

MAIL DATE

DELIVERY MODE

08/18/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/561,863	<b>Applicant(s)</b> RISBERG, PETER	
	<b>Examiner</b> Marcus Charles	<b>Art Unit</b> 3682	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,7 and 8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-5 and 7-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 May 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This action is responsive to the amendment filed 05-02-2008, which has been entered.

Claims 1, 3-5 and 7-8 are currently pending.

#### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1, 3-5 and 7-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, the phrase "maximum contact area is unclear and confusing because the phrase was not define so as one of ordinary skill in the art would be able to ascertain what level of contact can being referred to as "maximum contact". It appears "maximum contact" is subjective and relative". In addition In claim 1, it is not clear if the rotating unit" of line 5 is the same as that of line 8, if they are the same then there includes a double inclusion.

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 5 and 8, as understood are rejected under 35 U.S.C. 102(b) as being anticipation by WO 00/31426). WO 00/31426) discloses a rolling bearing (see figs. 1-5) comprising two coaxial bodies (see figs.2 and 4) comprising two rolling bodies (43/46),

one disposed outside each other, the two having two opposing surfaces having a number of rotating bearing balls (17, 42, therebetween; the balls are retained by grooves of the opposing surfaces; at least one of the bodies is a helical spring and is inherently dimensioned to take up forces exerted by the balls (see page 5, lines 28-31); the surface of the groove that interacts with the bearing balls is shape such that the maximum possible contact is obtained between the unit's outer surface and the corresponding outer surface of the groove. In addition, WO 00/31426) suggest that it is known that a wire can be ground when it has been wound to an initial shape to produce raceways with greater contact surfaces than obtained with a round wire in the spring (page 12, lines 25 to page 13, line 3). In addition, as can be seen, in figs. 1-5, e.g. fig 2, shows the groove interacting with a spherical ball bearing element and shape up to provide maximum possible contact.

In claim 5, note the spring has one or more grooves. In addition, the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight.

In claim 8, WO (0031426) discloses two sleeves (14/15) each having an associate groove (16/22) and a device (12) that holds the two sleeves together (see figs. 2) and 3-4).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3 -4 and 7, as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 00/31426). WO 00/31426) fails to clearly disclose the claimed invention. However, it would have been obvious to one of ordinary skills in the art to design the spring set forth in claims 2-4 and 7, since these technical requirements are well known in the art and would have been within the level of ordinary skill in the art.

### ***Response to Arguments***

7. Applicant's arguments filed 5-02-2008 have been fully considered but they are not persuasive. Applicant contended that he prior art fails to suggest disclose the surface in the groove interaction with rotatable unit being spherically shape that up to a maximum possible contact is obtained between the unit's outer surface and the corresponding surface of the groove. It should be noted that applicant has not defined as to what amount of contact can be considered maximum possible contact. It should also be noted that maximum contact is relative and subjective and that each maximum possible contact is related to a particular bearing and that each bearing has its own maximum possible contact.

In addition, applicant did not address the rejection of claim 8, since applicant has elected to amend claim 8 so that it is an independent claim. Applicant must provide a separate argument in response to the claim rejection.

Furthermore, there is reasons to believe, based on the similarity of (structure etc.) that the functional limitation (s) of the (maximum possible contact) being restricted

to "the groove and the unit" maybe (an) inherent characteristic (s) of (the prior art). In re accordance with In re Best, 562F.2d 1252, 195 USPQ 430, 433 (CCPA 1977).

This "burden of rebutting [may be of] the PTO's reasonable assertion of inherency under 35 USC 102, or of prima facie obviousness under 35 USC 103" (195 USPQ at 432).

Accordingly, the burden is placed upon the applicant to prove that the limitation (s) in question is/are not (an) inherent characteristic (s) of the reference disclosure.

For the reasons stated above the rejection is deemed proper.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marcus Charles whose telephone number is (571) 272-

7101. The examiner can normally be reached on Monday-Thursday 7:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ridley Richard can be reached on (571) 272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*Marcus Charles*  
/Marcus Charles/  
Primary Examiner, Art Unit 3682